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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/763,607	01/23/2004	Munir Uwaydah	016080-001	7270

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EXAMINER

SCHWARTZ, CHRISTOPHER P

ART UNIT	PAPER NUMBER
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3683

DATE MAILED: 05/09/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/763,607

Applicant(s)

UWAYDAH, MUNIR

Examiner

Christopher P. Schwartz

Art Unit

3683

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 February 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) 16-31 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

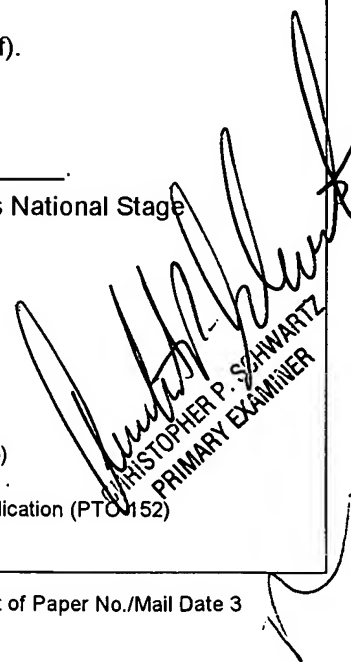
Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____


CHRISTOPHER P. SCHWARTZ
PRIMARY EXAMINER

DETAILED ACTION

Election/Restrictions

1. Applicant's election without traverse of the method of manufacture in the reply filed on 2/18/05 is acknowledged.

Claims 16-31 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 2/18/05.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 2-5,9-11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 2, in light of the specification, it is unclear what the difference is between the protrusions claimed in claim 2 and the discontinuities claimed in claim 1.

The same questions apply to claims 3,4,9-11.

Upon further consideration it appears the limitations of claim 5 should be claimed before those in claim 1 since the "discontinuities" are formed in the sheet before the plate is cut.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

Art Unit: 3683

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1,5,7,8,12,15 are rejected under 35 U.S.C. 102(b) as being anticipated by Nakao et al.

Regarding claim 1, as broadly claimed, Nakao et al. shows in figures 8 and 9 a method of manufacturing a backing plate. Note that the plate is punched or “cut” from a sheet material. The plate is then subject to a grinding operation.

Therefore, as broadly claimed, the backing plate is cut from a sheet having a plurality of discontinuities therein because all metal materials (or any other material for that matter) has “discontinuities” or imperfections therein.

Regarding claims 5,7 since the sheet has to be formed at some point during a “sheet manufacturing process” (inherent in the reference), and since it has discontinuities formed therein before being punched, in light of the explanation above, these requirements are met.

Regarding claim 8, as clearly seen in figures 10, these requirements are met.

Regarding claims 12,15 these requirements are met.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Art Unit: 3683

7. Claims 1-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Arbesman '047 in view of Nakao et al. and Naniwa et al..

Regarding claim 1, subject to the 112 rejection above, and subject to the interpretation that the "discontinuities" and the "protrusions" are one in the same, Arbesman shows a backing plate having the plurality of protrusions and channels at 4-6, as broadly claimed.

The reference to Naniwa et al. shows a punching and cutting techniques known in the art. However as seen in figure 4 at step 102, and as described in col. 9 lines 25-30, it is known to first form "discontinuities" in a sheet material before cutting it to desired dimensions.

Please also refer to figures 6-8.

The reference to Nakao et al. is relied upon as above.

It would have been obvious to have formed the protrusions/channels shown in Arbesman before a cutting operation as taught by Nakao et al. and Naniwa et al. simply as an alternative method of forming the backing plate of Arbesman. Such a reason may be that it would be easier to cut the backing plate (having the projections formed therein beforehand) to specific dimensions so that the inventive concept could be used for different vehicles with differently sized brakes.

The limitations of claims 2-15 are met by the combined teachings above. The "rolling process" is notoriously well known in the art, as indicated on page 8 of applicant's specification.

Art Unit: 3683

Response to Arguments

8. Applicant's arguments with respect to claims 1-15 have been considered but are moot in view of the new ground(s) of rejection.

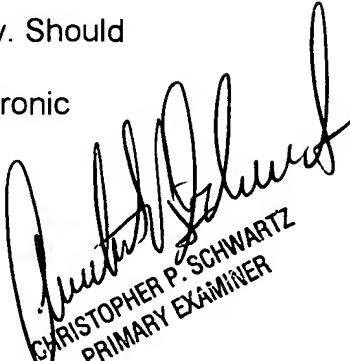
Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Applicant's should revisit the reference to Spigener. Contrast the known stamping and punching techniques taught therein with the disclosures in the references to Sinn et al. and Naniwa et al.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher P. Schwartz whose telephone number is 703-308-0576. The examiner can normally be reached on M-F 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dave Bucci can be reached on 703-308-3668. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


CHRISTOPHER P. SCHWARTZ
PRIMARY EXAMINER